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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,306	12/09/2003	James R. Harte	33994-CIP1	3637

7590

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EXAMINER

PURVIS, SUE A

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/731,306

**Applicant(s)**

HARTE ET AL.

**Examiner**

Sue A. Purvis

**Art Unit**

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-29 and 31-34 is/are allowed.
- 6) ☒ Claim(s) 1-20 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 10/460,711. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

3. Claims 1-20 are directed to the same invention as that of claims 1-20 of commonly assigned Application Number 10/460,711. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

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***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6-10, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kearney (US Patent No. 4,680,082).

Kearney discloses a labeling device with a label dispensing unit operable to deliver labels (16) to a label delivery location and a label transport and tamping assembly (38) operable to receive labels and to apply the delivered labels to packages. The assembly (38) includes a plurality of adjacent, hollow bodies created by bars (76, 76', 76''), each presenting a label-engaging end. The bodies are shiftable between a label-receiving position and a label-applying position by means of an electric solenoid (64). The device also includes means for maintaining a partial vacuum within said enclosure in order to cause a label to adhere to the outside of the face plate. (Col. 5, lines 19-53; Col. 10, lines 4-15.)

Regarding claim 6, the device in Kearney includes an actuator (64) for simultaneous shifting of the bodies between the label-receiving and label-applying positions.

Regarding claim 7, Kearney includes a label supply reel (12), a tensioning assembly (20), and a label peel bar (32).

Regarding claims 8 and 19, the device of Kearney includes a support assembly which supports it next to the conveyor (54) and the transport and tamping assembly (38) is coupled thereto and adjustable as a whole relative to the support assembly by means of the electric solenoid (64).

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Regarding claims 9 and 20, the shiftable bodies and apparatus mounted upon at least one slide plate (66) which operatively coupled to the support assembly.

Regarding claim 10, Kearney discloses a labeling method comprising the steps of moving labels to a label pickup location and moving the labels from the pickup location to a label-applying location in order to apply the labels against packages. The engaging and moving step comprising the steps of providing a plurality of adjacent, hollow bodies each presenting a label-engaging end, and shifting the bodies between a label-receiving position at said pickup location and a label-applying position, where a reduced pressure condition is created at the ends when the bodies are in the label-receiving position.

6. Claim 30 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hendrickson, Jr. (US Patent No. 3,991,440).

Hendrickson, Jr. discloses a roller with spaced apart bearings and openings which allow cleaning fluid there through.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kearney as applied to claims 1 and 10 above, further in view of Hughes (US Patent No. 3,379,466).

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Kearney discloses a labeling machine including a label dispensing unit and a label receiving and applying station (described in detail above), but does not disclose the bodies which create the label-engaging ends being comprised of "hollow plates".

Hughes discloses a label receiving and applying station (12) which includes a plurality of adjacent, hollow bodies (28) each presenting a label-engaging end and means for creating reduced pressure conditions at the label-engaging ends. As detailed in Hughes, the bodies (28) are made of parallel bars which create a space and are considered equivalent to applicant's hollow plates. (Col. 3, lines 40-69.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made that an alternative to boring holes into the plate to create the empty space used in the tamping assembly in Kearney would be to have a grid comprising a multiplicity of equally spaced bars as shown in Hughes. The ending structure is similar and both means of creating the structure are within the purview of the artisan.

Regarding claims 3 and 12, Kearney includes a fan assembly (86) and it the location of the fan is remote from the label-engaging ends.

9. Claims 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes in view of Kearney.

Hughes discloses a label tamping device comprising a plurality of adjacent, hollow plates located in side-by-side relationship for receiving a label and then applying it. Each of the plates presenting an open label-engaging end and an open remote end, and apparatus located proximal to said remote ends for drawing air through said hollow plates in order to create reduced pressure conditions at said label-engaging ends.

Hughes does not have the tamping assembly being shiftable.

Kearney discloses a tamping assembly which pivots from a label-receiving position to a label-applying position.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the tamping assembly in Hughes be pivotable allowing for easier handling of the label, because Kearney teaches of the advantages of such a feature, one advantage being that it allows for the label to be more easily separated from the backing strip.

Regarding claim 17, Kearney includes a fan assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a fan assembly in Hughes to create the reduced pressure environment, because doing so is well known in the art.

Regarding claim 18, Hughes in view of Kearney include a slotted manifold with the plates received within slots of said manifold and shiftable relative thereto.

***Allowable Subject Matter***

10. Claims 21-29 and 31-34 are allowed.

11. The following is an examiner's statement of reasons for allowance: Prior art does not teach or discuss limiting the ratio of the maximum transverse dimension of the void area in comparison with the outside diameter of the roll. Several rollers have void areas on the surface of the roller (See McNichols et al. - US Patent No. 6,149,755 and Hebert - US Patent No. 5,401,231), but there is no discussion which mentions the ratio claimed by the applicant.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

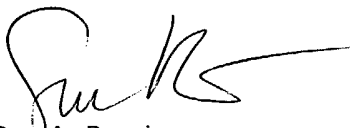
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**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis  
Examiner  
Art Unit 1734

SP  
April 16, 2004